

REMARKS

I. Status of Claims

Claim 1 is amended to clarify that each of the R¹² groups may be the same or different.

Claims 7-9 are canceled without prejudice or disclaimer.

No new matter is added. Further, the claim amendments do not present any new issues requiring further search and/or consideration. Accordingly, Applicants respectfully request entry and consideration of the Amendment. Upon entry of the Amendment, claims 1, 5, 6, 11 and 14-16 will be pending.

II. Response to Claim Rejection Under 35 U.S.C. § 112, second paragraph

Claims 7-9 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Without acquiescing to the merits, claims 7-9 are canceled, obviating the § 112, second paragraph rejection of the claims.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph rejection of claims 7-9.

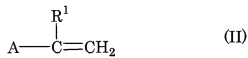
III. Response to Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1, 5-9, 11 and 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '472 (JP 63-101472) in view of Ohmori et al. (U.S. Patent No. 5,021,501).

Without acquiescing to the merits, claims 7-9 are canceled.

Claims 1, 5, 6, 11 and 14-16 are patentable over JP '472 in view of Ohmori, at least for the following reasons.

Claim 1 is drawn to a surface treatment agent that contains a silicon-containing fluoropolymer comprising repeating units derived from the fluorine-containing monomer of formula (I) and repeating units derived from a silicon-containing monomer represented by formula (II). Formula (II) has the following structural formula:



, where A is a monovalent group having at least one silicon atom represented by the formula: Rsi-X- , where Rsi is $\text{R}^{11}\text{-(Si(R}^{12}\text{)}_2\text{-O)}_p\text{-}$, and R^{11} and R^{12} are as defined in claim 1.

The silicon-containing monomer as defined in present claim 1 is not disclosed or suggested in the JP '472 or Ohmori. The silicon-containing monomer of claim 1 has a carbon-carbon double bond and a siloxane (-Si-O-Si-) linkage (or a -O-Si- linkage provided that the O atom is nearer to the carbon-carbon double atom than the Si atom).

In comparison, JP '472 discloses a diorganopolysiloxane (softener) which does not have a carbon-carbon double bond.

At column 3, lines 12-13, Ohmori discloses a silicon-containing monomer of the formula: $\text{CH}_2=\text{C}(\text{CH}_3)\text{COO-CH}_2\text{CH}_2\text{CH}_2\text{Si}(\text{OCH}_3)_3$, and at column 1, line 56, Ohmori discloses a monomer of formula (3): $\text{CH}_2=\text{C}(\text{X}^3)\text{C(=O)-O-R}^1$. In formula (3), R^1 represents silicon-containing groups such as trimethylsilyl and trimethylsilylpropyl. The silicon-containing monomer disclosed in Ohmori does not have a siloxane (-Si-O-Si-) linkage (or a -O-Si- linkage provided that the O atom is nearer to the carbon-carbon double atom than the Si atom). Therefore, Ohmori does not teach or suggest the structure of the silicon-containing monomer of formula (II) as defined in present claim 1.

In view of the above, claim 1 is patentable over the combination of JP '472 and Ohmori. Claims 5, 6, 11 and 14-19 are also patentable, at least by virtue of their dependence from claim 1. Therefore, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 1, 5, 6, 11 and 14-19.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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